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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,578	11/30/2000	Peter Bishop	ELX-64	4338
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			2682	13

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,578

Applicant(s)

BISHOP ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,17-20,24 and 30-33 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16, 21-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al. (US 5,894,597).

Regarding claim 10, Schwartz teaches an electronic card reader (fig. 1) for a mobile communications device, comprising: a housing 102; an electrical assembly, the assembly comprising a first set of electrical contacts 106 (fig. 2) and a second set of electrical contacts 416 (fig. 4) carried upon the housing, further wherein said electrical contacts are adapted for flexible engagement (fig. 4); a first card holder slide assembly 110 (fig. 1) adapted to receive a first subscriber identity module (SIM) electronic card 108; a second card holder slide assembly 104 adapted to receive a second subscriber identity module (SIM) electronic card 101;

wherein the first set of electrical contacts engage the first SIM card and the second set of electrical contacts engage the second SIM card (col. 2, lines 31-32).

3. Claims 1-5, 9-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tayloe (US 5,987,325) submitted by Applicant.

Regarding claims 1 and 10, Tayloe teaches a card reader (fig. 1), comprising: a housing 101 (fig. 2); inherently a first set of electrical contacts in SIM CARD READER 107 (fig. 2) carried upon the housing; inherently a second set of electrical contacts 107 in SIM CARD READER 107 (fig. 2) carried upon the housing; a first card holder slide assembly 107 (figs. 1-2) adapted to receive a first electronic card 105; and a second card holder slide assembly 107 (figs. 1-2) adapted to receive a second electronic card 105; and said housing 102 in communication with both said first card holder slide assembly and said second card holder slide assembly (col. 3, lines 51-60, col. 4, lines 26-28).

Regarding claim 2, Tayloe also teaches that the first electronic card comprises a subscriber identity module (SIM) card (col. 4, line 26).

Regarding claim 3, Tayloe also teaches that both the first and second electronic cards comprise subscriber identity module (SIM) cards (col. 4, line 26).

Regarding claim 4, Tayloe also teaches that the first and second electronic cards 105 are substantially the same size (fig. 1).

Regarding claim 5, Tayloe also teaches that the first set of electrical contacts and the second set of electrical contacts 107 are carried upon a common electrical assembly 101, 117 (fig. 2).

Regarding claim 9, Tayloe also teaches that the reader operates in a cellular phone (fig. 1 of Tayloe).

Regarding claim 12, Tayloe also teaches the SIM cards are substantially rectangular in shape (fig. 1, 105).

4. Claims 1-10, 12-16, 21-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Bricaud et al. (WO 00/17806) submitted by Applicant.

Regarding claims 1 and 10, Bricaud teaches a card reader (fig. 37), comprising: a housing 50; a first set of electrical contacts 100 carried upon the housing; a second set of electrical contacts 146 in carried upon the

housing; a first card holder slide assembly 152 adapted to receive a first electronic SIM card 56 (col. 19, line 24); and a second card holder slide assembly 154 separate from the first card holder slide assembly 152 adapted to receive a second electronic SIM card 58 (col. 19, line 29); and said housing 50 in simultaneous electrical contact with both said first card holder slide assembly and said second card holder slide assembly (abstract).

Regarding claim 2, Bricaud also teaches that the first electronic card comprises a subscriber identity module (SIM) card (col. 2, line 5 and lines 18-19).

Regarding claim 3, Bricaud inherently teaches that both the first and second electronic cards comprise subscriber identity module (SIM) cards (col. 2, lines 18-24 and line 5).

Regarding claim 4, Bricaud also teaches that the first and second electronic cards 105 are substantially the same size (col. 4, lines 4-5).

Regarding claim 5, Bricaud also teaches that the first set of electrical contacts and the second set of electrical contacts 56, 58 are carried upon a common electrical assembly 54 (fig. 35).

Regarding claim 6, Bricaud teaches contact elements which are constructed by elongated elements 100, 146 (fig. 25).

Regarding claim 7, Bricaud also teaches that the elongated contact elements further comprise curved, resilient contact tips adapted for electrical communication with said electronic cards (see fig. 25, numerals 100, 146).

Regarding claim 8, Bricaud also teaches that the elongated contact elements electrically engage said first and second electronic cards at multiple contact points (fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 9, Bricaud also teaches that the reader operates in a cellular phone (col. 2, lines 25-26).

Regarding claim 12, Bricaud also teaches the SIM cards are substantially rectangular in shape (fig. 35, numerals 56, 58).

Regarding claim 13, Bricaud also teaches that said first and second card holder slide assemblies each comprise a flat base with a plurality of side walls, further wherein the first and second SIM cards each are adapted for placement in a position upon the flat base of the first and second card holder slide assemblies, respectively, such that the SIM cards are oriented

substantially between side walls and securely within said holder slide assemblies (see fig. 35).

Regarding claim 14, Bricaud also teaches that at least one card holder slide assembly comprises an aperture window (fig. 36, numeral 58).

Regarding claim 15, Bricaud also teaches that said first set of electrical contacts are elongated and are provided in a substantially parallel arrangement (numeral 100, 146, fig. 25).

Regarding claim 16, Bricaud also teaches that the elongated electrical contacts each comprise a proximal end and a distal end, wherein the distal ends of said elements are curved to facilitate resilient engagement with said SIM cards (100, 146, fig. 25).

Regarding claim 21, the claims is interpreted and rejected for the same reason as set forth in claim 10.

Regarding claim 22, Bricaud also teaches inserting the second SIM card 58 into the second card holder slide assembly 154 to form a second loaded slide assembly; placing the second loaded slide assembly into operative position within the housing 50; and engaging the second set of electrical contacts 146 with the second SIM card 58 (fig. 35).

Regarding claim 23, the claims is interpreted and rejected for the same reason as set forth in claim 10.

Regarding claim 25, the claim is interpreted and rejected for the same reason as set forth in claim 12.

Regarding claim 26, the claim is interpreted and rejected for the same reason as set forth in claim 13.

Regarding claim 27, the claim is interpreted and rejected for the same reason as set forth in claim 14.

Regarding claim 28, the claim is interpreted and rejected for the same reason as set forth in claim 15.

Regarding claim 29, the claim is interpreted and rejected for the same reason as set forth in claim 16.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6-9, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tayloe in view of Bricaud.

Regarding claim 6, Tayloe does not explicitly teach that the electrical contacts comprise elongated contact elements. In the same field of art, Bricaud teaches contact elements are constructed by elongated elements 100, 146 (fig. 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Bricaud to the card reader of Tayloe in order to enhance contacting between the cards and the card reader.

Regarding claim 7, Tayloe as modified by Bricaud also teaches that the elongated contact elements further comprise curved, resilient contact tips adapted for electrical communication with said electronic cards (see fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 8, Tayloe as modified by Bricaud also teaches that the elongated contact elements electrically engage said first and second electronic cards at multiple contact points (fig. 25, numerals 100, 146 of Bricaud).

Regarding claim 9, Tayloe as modified by Bricaud also teaches that the reader operates in a cellular phone (fig. 1 of Tayloe).

Regarding claim 13, Tayloe as modified also teaches that said first and second card holder slide assemblies each comprise a flat base with a plurality of side walls, further wherein the first and second SIM cards each are adapted for placement in a position upon the flat base of the first and second card holder slide assemblies, respectively, such that the SIM cards are oriented substantially between side walls and securely within said holder slide assemblies (see fig. 35 of Bricaud).

Regarding claim 14, Tayloe as modified by Bricaud also teaches that at least one card holder slide assembly comprises an aperture window (fig. 36, numeral 58 of Bricaud).

Regarding claim 15, Tayloe as modified by Bricaud also teaches that said first set of electrical contacts are elongated and are provided in a substantially parallel arrangement (numeral 100, 146, fig. 25 of Bricaud).

Regarding claim 16, Tayloe as modified by Bricaud also teaches that the elongated electrical contacts each comprise a proximal end and a distal end, wherein the distal ends of said elements are curved to facilitate resilient engagement with said SIM cards (100, 146, fig. 25 of Bricaud).

Response to Arguments

8. Applicant's arguments filed 3/17/2004 have been fully considered but they are not persuasive.

SCHWARTZ REJECTION

Regarding the rejection of independent claim 10, Applicant argues that the claim requires "wherein the first set of electrical contacts engage the first SIM card and the second set of electrical contacts engage the second SIM card", and Schwartz's disclosure does not contain such a

configuration because Schwartz's disclosure is for electrical contact with the first card "or" the second card.

The examiner disagrees. The claim does not requires that the first set and second set of electrical contacts simultaneously engages the first and second SIM card, respectively. Therefore, Schwartz still anticipates claim 1 limitation.

TAYLOE REJECTION

Regarding the rejection of independent claims 1 and 10, Applicant contends that the SIM card readers 107 in figures 1 and 2 of Tayloe can not be read as card holder slide assemblies with electronic cards as required by the claims.

In response, the examiner respectfully disagrees. Applicant's card holder slide assemblies with electronic cards are used to read information from the electronic SIM cards. The card readers 107 of Tayloe provide the same function, i.e. they are used to read electronic SIM cards. One having skilled in the art would recognize the indifference between the claimed language and Tayloe's disclosure. Therefore, Tayloe does anticipate the limitation of claims 1-5, 9-10 and 12.

BRICAUD REJECTION

Bricaud can not anticipate the claims under 35 U.S.C. 102(b), but the reference still anticipates the claims under 35 U.S.C. 102(a). It is just a typographical error.

Applicant further contends that Bricaud does not teach the first and second card holder assembly as recited in claims 1 and 10. Instead Bricaud only discloses a single card holder assembly.

In response, the examiner respectfully disagrees. In Bricaud, the first card assembly 152 used to hold the first SIM card 56 (figs. 9, 11) is separated from the second card assemble 154 used to hold the second SIM card 58 (figs. 9, 12). Consequently, the card assembly 152 is separated from the second card assembly 154. Therefore, claims 1-10, 12-16 and 21-29 are anticipated by Bricaud.

COMBINATION OF TAYLOE AND BRICAUD

Regarding the rejection of claim 8, Applicant contends that no disclosure in either Tayloe or Bricaud suggests a combination.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, providing the teaching of Bricaud to the card reader of Tayloe enhances contacting the cards and the card reader.

Regarding the rejection of claim 13, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the rejection of claim 15, Applicant contends that Bricaud component 58 in figure 36 is not an aperture window, rather it is a card.

In response, the examiner understands that. The question is that what is the claimed aperture window. No specific definition recited in the claim that defines this window. Therefore, as seen in figure 36 of Bricaud, one can not see the card 58 without a window of the card assembly 54.

Allowable Subject Matter

10. Claims 11, 17-20, 24, 30-33 were allowed.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/19/04
LEE NGUYEN
Primary Examiner
Art Unit 2682